

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:)	
)	
Fan, et al.)	Confirmation No.: 3917
)	
Application No.: 09/696,446)	
Patent No.: 7,574,606)	
)	
Filing Date: 10/24/2000)	
)	
For: Location Authentication)	
Stamp Attached to Messages)	
_____)	

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Request for Reconsideration of Patent Term Adjustment Indicated in Issue Notification

Dear Sir:

In response to the Issue Notification, which established an issue date of 8/11/2009, Petitioners respectfully request review of the calculated Patent Term Adjustment to ensure that an error was not made. This Request/Petition is being filed pursuant to 37 CFR §1.705(d) and in accordance with the requirements of paragraphs (b)(1) and (b)(2) of the same section. Please consider the following remarks.

REMARKS

1. This request is for reconsideration of the patent term adjustment indicated in the Issue Notification. A previous request for reconsideration was filed under 37 CFR §1.705(b) following the notice of allowance, but was ruled untimely (too early) and “HELD IN ABEYANCE” by the USPTO in a “decision” mailed July 13, 2009. The response suggested that the Petitioners could re-file for adjustment for two months following issuance, and that a copy of the decision should be submitted with the re-filing. The decision also indicated that reconsideration of patent term adjustment could be sought without payment of an additional fee, as the \$200 fee had already been paid.

2. Petitioners submit herewith:

- a. A copy (attached) of the July 13, 2009 decision on the previous petition for PTA.
- b. A “Statement of the Correct Patent Term Adjustment: Basis(es) under 1.702 for the Adjustment,” in compliance with 37 CFR 1.705 (b)(2)(iv)(B).

3. The patent granted is not, to Petitioners’ knowledge, subject to any terminal disclaimer.

4. As to circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 1.704 (37 C.F.R. 1.705(b)(2)(iv)), there were as follows (37 C.F.R. 1.705(b)(2)(iv)(A)):

- 12/28/2004, Applicant delay of 89 days in filing response;
- 10/24/2005, RCE filed with Applicant delay of 87 days;
- 3/03/2006, Applicant delay of 3 days in filing response;
- 10/20/2006, Applicant delay of 91 days filing Notice of Appeal;
- 11/05/2007, RCE filed;

- 3/28/2008, Applicant delay of 2 days in filing response; and
- 9/09/2008, RCE filed.

5. The fee set forth in 1.18(e) (\$200.00), required by 37 C.F.R. 1.705(b)(1), is paid as follows:

- Per the decision of 13 July 2009 (attached hereto) no fee should be required.
- However, if any fee is required, please charge Deposit Account 50-4157. At any time during the review of this request/petition, please charge any fees required or credit any over payment to Deposit Account 50-4157 pursuant to 37 CFR 1.25.

Respectfully submitted,

WAGNER BLECHER LLP

Dated: October 13, 2009

/John P. Wagner, Jr./

John P. Wagner, Jr.
Registration No.: 35,398

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I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300 or via electronic submission.

Typed Name: Brenda Dinapoli

Date of Deposit: 13 Oct 2009

Signature: /Brenda Dinapoli/

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STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: BASIS(ES) UNDER
 1.702 FOR THE ADJUSTMENT (37 C.F.R. 1.705(b)(2)(i) and (ii))

1. This statement is being submitted in support of the "Request for Reconsideration of Patent Term Adjustment Indicated in Issue Notification" to which this statement is attached.

37 C.F.R. 1.705(b)(2)(i)

2. The patent term adjustment shown on the Notice of Allowance and in the Issue Notification is: 648 days. It is respectfully suggested that the correct patent term adjustment under 1.702 is: 952 days.

37 C.F.R. 1.705(b)(2)(ii)

3. Under 1.705(b)(2)(ii) applicant must set forth: "The relevant dates as specified in 1.703(a) through(e) for which an adjustment is sought and the adjustment as specified in 1.703(f) to which the patent is entitled." The adjustment is sought for the following date range: between 6/30/2004 and 10/24/2005. Adjustment to be made for this date range: 304 days.

The basis on which the Petitioners seek adjustment is as follows: An initial Office Action was received 918 days after the 14-month date after filing. The 3-year date following filing was 10/24/2003. The 3-year rule to allowance was violated by 480 days that did not overlap with the 14-month violation of 918 days (subtraction of applicant delays of 87 and 89 days reduces the 3-year delay to 304 days). Per *Wyeth v. Dudas* (580 F. Supp. 2d 138; 88 U.S.P.Q.2D (BNA) 1538, September 30, 2008), USPTO's view that any administrative delay under 35 U.S.C.S. § 154(b)(1)(A) overlapped any three-year maximum pendency delay under § 154(b)(1)(B) could not be squared with language of § 154(b)(1)(B), as "B delay" began when PTO had failed to issue patent within three years, not before. As the instant patent was not issued within three years of filing and includes non-overlapping periods of both 14-month rule delay and 3-year rule delay, Petitioners submit that the holding of *Wyeth v. Dudas* should be applied in the calculation of PTA. In accordance with this ruling Petitioners submit that the total PTA should = 648 days + 304 days, for a total of 952 days, rather than the 648 days indicated on the issue notification.

Respectfully submitted,

WAGNER BLECHER LLP

Dated: October 13, 2009

/John P. Wagner, Jr./

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Registration No.: 35,398

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Typed Name: Brenda Dinapoli

Date of Deposit: 13 Oct 2009

Signature: /Brenda Dinapoli/



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WATSONVILLE CA 95076

MAILED

JUL 13 2009

In re Application	:	OFFICE OF PETITIONS
Carey B. Fan et al.	:	
Application No. 09/696,446	:	DECISION ON APPLICATION
Filed: October 24, 2000	:	FOR PATENT TERM ADJUSTMENT
Attorney Docket No. TRMB-2106	:	

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. 1.705) filed May 8, 2009. Applicant requests that the determination of patent term adjustment be corrected from six hundred forty-eight (648) days to nine hundred fifty-two (952) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **HELD IN ABEYANCE** after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). This is true even in this instance where a request for continued examination (RCE) was filed.

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent

term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Examination Policy